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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,208	10/20/2003	Triveni P. Shukla	00030-001	4476

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EXAMINER	
PEARSE, ADEPEJU OMOLOLA	
ART UNIT	**PAPER NUMBER**
1761	

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/689,208	SHUKLA ET AL.	
	Examiner	Art Unit	
	Adepeju Pearse	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims snack products comprising an emulsified liquid shortening composition; the composition comprises dietary fiber gel, water and lipid. The gel is an essential element to the composition; however, the specification does not teach how to form the gel or how the gel is mixed with water and lipid to form the emulsified liquid shortening composition. How much water and lipid are needed? What kind of lipid can be used? There is no disclosure of how the gel is made and how the shortening composition is made. One skilled in the art would not know how to make the composition and snack from reading the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al (U.S. Pat. No. 6,048,564) in view of Stone (U.S. Pat. No. 6,391,864). With regard to claims 1-6, Young et al disclose a bakery-shortening substitute. The shortening substitute may be an oil-in-water emulsion or water-in-oil emulsion. The emulsion comprises water, konjac gel and lipid. Other hydrocolloids are included in the konjac gel. Highly preferred combination is konjac with microcrystalline cellulose. The shortening can replace shortening and other conventional fats in bakery food formulations on a one-to-one volume basis. The shortening substitute is used in cookies. It is well known that cookies are a form of snack foods (See col. 3 lines 7-13, col. 6 lines 40-45, col. 9 lines 19-39, and col. 11 lines 1-31). However, Young et al failed to disclose

the amount of solid delivered by the fiber gel and the other forms of snack foods i.e. chips, crackers, candy, granola bars and snack bars as instantly claimed. The Office interprets the reference teachings of bakery products to encompass chips; crackers, granola bars and snack bars because these are well known baked foods in the art. While Young et al does not use the term dietary fiber gel, the konjac gel is a dietary fiber gel because konjac is a soluble dietary fiber as evidenced by Stone (col. 2 line 28). Regarding the amount, Young et al teach that the shortening substitute can replace the fat in conventional formulations on a one-to-one basis; thus, the amount of solid in the fiber gel can vary depending on the snack formulation and the amount of fat present in such formulation. It would have been obvious to one skilled in the art to use any known snack formulation depending on the taste, flavor and texture desired.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGinley (US Pat. No 5 192 569). McGinley discloses food products containing an aqueous dispersion comprised of a dietary fiber gel, water and lipid. McGinley discloses the use of microcrystalline cellulose (see Column 4, lines 15-16), which is a source of dietary fiber and is a gel in water (see Column 3, lines 39-50), therefore is a dietary fiber gel. McGinley discloses the use of a lipid with the dietary fiber gel (see Column 6, lines 45-68). McGinley discloses adding the dietary fiber and lipid to water to form an aqueous dispersion (see Column 7, lines 59-63) and then adding that aqueous dispersion to a food product as a fat replacement (see Column 1, lines 25-30 and 36-37). The aqueous dispersion as disclosed by McGinley comprises a dietary fiber gel, water and lipid, thus, it is the same as the emulsified liquid shortening composition, even though such term is not used in the reference. McGinley discloses that the solids contained within the dietary fiber gel

represent 1-50% by weight of the overall food formulation (see Column 8, lines 5-20). McGinley teaches the use of the mixture of dietary fiber gel, water and lipid in dry or dispersed form in various foodstuffs including dairy products (see abstract, Column 7, lines 1-2 and lines 57-68). McGinley is silent as to utilizing this emulsion in candy product. However, the Office interprets dairy products to encompass candy products including chocolate candy that are dairy based. It would be obvious to one of ordinary skill in the art to utilizing the teachings of McGinley et al to provide a fat substitute in order to have a low calorie candy product.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In *re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/878,858 in view of Young et al (U.S. Pat. No. 6,048,564) and McGinley et al (U.S. Pat. No.

5,192,569). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application claim a snack food, the snack food having a formulation, the snack food comprising emulsified liquid shortening composition comprising dietary fiber gel, water and lipid, wherein the emulsified liquid shortening composition comprising dietary fiber gel, water and lipid is added in a prorated amount such that solids contained within the dietary fiber gel represent 0.1 percent to 5.0 percent by weight of the overall snack food formulation, and the emulsified liquid shortening composition comprising dietary fiber gel, water and lipid replaces an equal amount of fat used in an otherwise identical recipe of snack food that uses no emulsified liquid shortening compositions comprising dietary fiber gel, water and lipid. Claims 2-6 claim more specific snack product i.e. chips, crackers, candy, granola bars and snack bars. The claimed matter of the instant application can also be found in claims 1-6 of Application 10/878,858. Application No. 10/878,858 claims that the solids contained within the dietary fiber gel represent 0.1 percent up to 8.0 percent by weight of the overall food formulation, which falls within the range as claimed in the instant application. Application No. 10/878,858 does not claim that the emulsified liquid shortening composition comprises water and lipids.

Young et al disclose a bakery-shortening substitute. The shortening substitute may be an oil-in-water emulsion or water-in-oil emulsion. The emulsion comprises water, konjac gel and lipid. Other hydrocolloids are included in the konjac gel. Highly preferred combination is konjac with microcrystalline cellulose. The shortening can replace shortening and other conventional fats in bakery food formulations on a one-to-one volume basis. The shortening substitute is used in cookies. It is well known that cookies are a form of snack foods. Bakery products are interpreted

to encompass chips; crackers, granola bars and snack bars because these are well known baked foods in the art. McGinley discloses food products containing an aqueous dispersion comprised of a dietary fiber gel, water and lipid. McGinley discloses that the solids contained within the dietary fiber gel represent 1-50% by weight of the overall food formulation (see Column 8, lines 5-20). McGinley teaches the use of the mixture of dietary fiber gel, water and lipid in dry or dispersed form in various foodstuffs including dairy products (see abstract, Column 7, lines 1-2 and lines 57-68). Dairy products are interpreted to encompass candy products including chocolate candy that are dairy based. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the emulsified liquid shortening composition as claimed in Application 10/878,858 in snack products taught by McGinley et al and Young et al since both are directed to dietary fiber gels as food fat substitutes and since using the high fiber gel in a snack product would impart a fat-like mouth feel and consistency without the caloric value of fat (see McGinley, Abstract, lines 14-15).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art discloses applicable subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adepeju Pearse whose telephone number is 571-272-8560. The examiner can normally be reached on Monday through Friday, 8.00am - 4.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peju Pearse
Art Unit 1761

CAROLYN PADEN 1761
PRIMARY EXAMINER 4-12-06